APPENDIX—FEDERAL STATUTES AND FEDERAL COURT RULES.

Rules of United States Court of Appeals for the 3rd Circuit.

Sec. 4915 R.S., 35 U.S.C.A., Sec. 63, Prior to August 5, 1939 Amendment.

SUITS TO OBTAIN PATENT

Sec. 4915. (U.S.C., title 35, sec. 63.) Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirments

of law. In all cases where there is no opposing party a copy of the bill shall be served on the Commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expense, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Sec. 4918 R.S., 35 U.S.C.A., Sec. 66.

§ 66. Interfering patents; relief against

Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both of the patents void in whole or in part, upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. R.S. § 4918; March 2, 1927, c. 273, § 12, 44 Stat. 1337.

Rule 25(c) Federal Rules of Civil Procedure.

(c) TRANSFER OF INTEREST. In case of any transfer of interest, the action may be continued by or against the original party, unless the court upon motion directs the person to whom the interest is transferred to be substituted in the action or joined with the original party. Service of the motion shall be made as provided in subdivision (a) of this rule.

Rule 54(b) Federal Rules of Civil Procedure.

(b) JUDGMENT UPON MULTIPLE CLAIMS. When more than one claim for relief is presented in an action, whether as a claim, counterclaim, cross-claim, or third party claim, the court may direct the entry of a final judgment upon one or more but less than all of the claims only upon an express determination that there is no just reason for delay and upon an express direction for the entry of judgment. In the absence of such determination and direction, any order or other form of decision, however designated, which adjudicates less than all the claims shall not terminate the action as to any of the claims, and the order or other form of decision is subject to revision at any time before the entry of judgment adjudicating all the claims.

Rule 35 (1) (2) (3).

COSTS

(1) WHEN CASE DISMISSED. In all cases where an appeal or petition shall be dismissed in this court, costs shall be allowed to the appellee or respondent, unless otherwise agreed by the parties or ordered by the court, except where the dismissal shall be for want of jurisdiction, when only the costs incident to the motion to dismiss shall be allowed.

(2) WHEN JUDGMENT, ORDER OR DECREE AFFIRMED. In all cases of affirmance of any judgment, order or decree in this court, costs shall be allowed to the appellee or respondent, unless otherwise ordered by the court.

(3) WHEN JUDGMENT, ORDER OR DECREE IS REVERSED. In cases of reversal of any judgment, order or decree by this court, costs shall be allowed to the appellant or petitioner, unless otherwise ordered by the court. The cost of assembling, certifying and transmitting the record on appeal from the district court shall be taxable in that court as costs in the case.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 448.

NICHOLAS L. ETTEN,

Petitioner,

v.

WALTER L. KAUFFMAN, II, and LOVELL MANUFACTURING COMPANY.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF IN OPPOSITION.

RALPH HAMMAR,
FRANK ZUGELTER,
Attorneys for Respondents.

BATAVIA TIMES, LAW PRINTERS,
BATAVIA, N. Y.

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BRIEF IN OPPOSITION.

Opinions Below.

The Opinion of the Court of Appeals (R. 210-221) is reported at 184 F. 2d 737. An earlier Opinion of the Court of Appeals (R. 169-170) is reported at 179 F. 2d 302. The Opinion of the District Court is reported at 83 F. Supp. 178.

Jurisdiction.

The Judgment of the Court of Appeals was entered September 29, 1950 (R. 222). The Petition for a Writ of Certiorari was filed December 11, 1950. The Jurisdiction of this Court is invoked under 28 USC 1254 (1).

Questions Presented.

1. Whether the Court of Appeals, upon noticing facts leading it to believe that petitioner's entire case might be

moot because of the lack of a justiciable interest in petitioner was not correct in entering an Interlocutory Judgment vacating the Judgment of the District Court and remanding the case so that the question of mootness and other relevant questions could be investigated and the danger of rendering an advisory opinion could be avoided.

2. Whether this Court should consider upon the merits, the errors in the judgment of the District Court which the Court of Appeals did not reach because of the danger of rendering an advisory opinion.

Statement.

I. Significant Misstatements in the Petition and Supporting Brief.

The Petition and Brief in Support of the Petition make the following misstatements regarding the Opinions and Judgment of the Court of Appeals:

(1) Petitioner refers to the Judgment of the Court of Appeals as Final. See Petition Foot Note 2 and Brief in Support of Petition, page 5 line 8. The Judgment is not Final but is Interlocutory.

(2) Petitioner repeatedly states that the Court of Appeals decided or conceded that the District Court had jurisdiction of the subject matter of petitioner's claim. For example see page 13 of the Petition where the following appears:

> "* * * notwithstanding the fact that the Court of Appeals conceded in its opinion that the Court below had jurisdiction at the time the suit was filed?"

See Petition page 10, last three lines; page 11, lines 3 and 4 from the bottom. See Brief in Support of Petition, page 7, lines 5 to 9 from the bottom; page 11, lines 3 to 5; and page 17 the last three lines.

Actually, the Court of Appeals went no further than to indicate that the District Court had personal jurisdiction of the parties (R. 219). The Opinion as a whole indicates that jurisdiction of the subject matter of Petitioner's claim is very much in doubt and that additional facts must be investigated if the obscurity is to be removed. It is precisely this obscurity which led the Court of Appeals to vacate the Judgment of the District Court and to remand the case for investigation of the fundamental facts of jurisdiction.

II. Significant Omissions in Petitioner's Statement.

(1) Background.

Petitioner's lengthy statement does not fully inform the Court of the background of the litigation.

Petitioner does not state that this case grew out of four Patent Office Interferences, which both Petitioner and the Patent Office treated as involving essentially the same inventive subject matter. Petitioner succinctly expressed the close relation between these four interferences to the Patent Office in the following language:

> "The structure forming the basis for all the companion interferences is a relatively simple toggle reset and release mechanism for wringers. The several interferences and the counts therein represent claims which differ merely in scope. It is urged that all of the claims in the four companion interferences vary but slightly in scope and that priority of the fundamental and basic inventive thought of the toggle release and reset mechanism to one party would negative any question of invention to the other party." (Df. Ex. 3B, pp. 24, 25)

NOTE: Petitioner has requested that the physical and paper exhibits be certified, but these have not been filed as yet.

The two interferences involved in this proceeding (Nos. 75433 and 76987) were declared before the August 5, 1939 amendment to Sections 4904, 4911 and 4915 of the Revised Statutes, c. 451, Sections 1, 3, 4, 53 Stat. 1212. The other two interferences (Nos. 77671 and 77672) were declared after the August 5, 1939 amendment. All four interferences involved the same Jantz application S. N. 749977, assigned to Respondent, Lovell Manufacturing Company. If it becomes material, the relationship of the four interferences to the patent which issued on the Jantz application can be ascertained from the foot note.[1]

Although all four interferences were not declared at the same time, the interferences were prosecuted concurrently in the Patent Office, each party using the same testimony

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[1]

Interference 75433 between Etten application S. N. 38932, filed September 3, 1935 and Jantz application S. N. 749977, filed October 25, 1934 since issued as Jantz Patent No. 2,406,951	Count 1—Jantz Patent Claim 30
Interference 76987 between Etten application S. N. 167775, filed October 7, 1937 for reissue of Patent 2,054,970 and the same Jantz Application S. N. 749977	Count 1—Jantz Patent Claim 36 Count 2—Jantz Patent Claim 35 Count 3—INVALID—No Jantz claim
Interference 77671 between Etten application S. N. 38932, filed September 3, 1935 and same Jantz application S. N. 749977	Count 1—Jantz Patent Claim 31 Count 2—Jantz Patent Claim 32 Count 3—Jantz Patent Claim 24 Count 4—Jantz Patent Claim 27 Count 5—Jantz Patent Claim 11 Count 6—Jantz Patent Claim 13
Interference 77672 between Etten Patent 2,054,970 granted on its face to Chamberlain Corporation and the same Jantz application S. N. 749,977	Count 1—Jantz Patent Claim 34

Note: None of the above listed Jantz Patent Claims is identical with the corresponding interference count. Amendments were made during the succeeding Patent Office prosecution, some at the instance of Jantz and others required by the Patent Office.

and exhibits, and the initial Patent Office decisions being decided on the same day, April 23, 1942, with opinions, which were in substance and even for the most part, in words, identical (Appellants' Appendix No. 10013, pp. 77 a-81 a, 98 a-102 a, 109 a-110 a, 111 a-114 a).

Because of the accelerated procedure provided by the August 5, 1939 amendment, the two later declared interferences, Nos. 77671 and 77672, were on April 23, 1942 immediately ready for review of the Final Patent Office Decision. Interference No. 77671 in which Etten[2], the loser, had the status of an applicant, could have been taken either to the Court of Customs and Patent Appeals under Section 4911 R. S. or to the District Court under Section 4915 R. S. or to the District Court under Section 4915 R. S. Interference No. 77672 in which Etten[2], the loser, had the status of a patentee, could only be taken to the Court of Customs and Patent Appeals under Section 4911 R. S. Etten elected to take Interference No. 77671 to the Court of Customs and Patent Appeals along with Interference No. 77672.

The two interferences involved in this proceeding, Nos. 75433 and 76987, had to follow the slower Patent Office procedure in effect prior to the August 5, 1939 amendment, so that these interferences had to be taken to the Patent Office Board of Appeals, which did not hand down its decision until April 24, 1943 (Appellants' Appendix No. 10013, pp. 85 a-92 a, 106 a-108 a). Accordingly, it was not until April 24, 1943 that the two interferences in this proceeding were ready for review of the Final Patent Office Decision. While these two interferences both could have been taken to the Court of Customs and Patent Appeals under Section 4911 R. S., Etten elected to file a Bill in Equity under Section 4915 R. S., the present suit.

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[2] Under Patent Office Practice, interferences are conducted under the names of the inventors, not under the names of the real parties in interest.

Before the present suit came to trial, the Court of Customs and Patent Appeals on January 3, 1944 handed down its decision in the other two co-pending interferences, (77671 and 77672), *Etten v. Jantz.* 142 F. 2d. 680, and specifically held, as a fact, that the wringer exemplified by Jantz Exhibit "O" was reduced to practice at least as early as April 10, 1932. The April 10, 1932 date was established by the birth record (Jantz Exhibit "W") of a prize cat owned by Mr. and Mrs. Onck. Onck was one of the mechanics who had to do with the construction of one or more of the wringers like Jantz Exhibit "O". Although this Cat Record was only approximate—"Might possibly be off one or two days" (Appellants' Appendix 10013, page 201 a), the depositions are clear that Mr. and Mrs. Onck associated the building of one of the wringers like Jantz Exhibit "O" with the birth of their prize cat and that the birth of the prize cat took place approximately at the date shown on the record. The Opinion of the District Court makes the disparaging statement:

> "* * * the effort that was made to find some event that occurred in the Spring of 1932 which could be used as a tie-in date and which resulted in the unfortunate choice of April 10, 1932." (Appellants' Appendix No. 10013, p. 53 a)

There is nothing in the record to support this statement. See Appellants' Appendix No. 10013, pp. 192 a-202 a; Appendix to Appellants' Reply Brief No. 10013, pp. 9 a, 15 a-38 a and Appendix to Appellants' Brief No. 10186, pp. 64 a-77 a.

Petitioner made no attempt to overturn the decision of the Court of Customs and Patent Appeals, 142 F. 2d 680 and this decision still stands unreversed and unmodified. The District Court in the trial of the present case did not accept the decision of the Court of Customs and Patent Appeals as controlling, but made its own independent determination.

Accordingly, we have, as a result of the District Court decision in this case, precisely the situation Congress sought to eliminate by the 1927 amendment of Sections 4911 and 4915 of the Revised Statutes (Sections 8 and 11 of the Act of March 2, 1927, 44 Stat. 1336) namely decisions between the same parties and on the same question of priority by the District Court under Section 4915 and by the Court of Customs and Patent Appeals under Section 4911.[3]

Respondents contended to the Court of Appeals that it was error for the District Court under 4915 to take up any matter which had been adjudicated by the Court of Customs and Patent Appeals under Section 4911 in the case *Etten v. Jantz*, 142 F. 2d 680.[4]

(2) FRAUD.

Because of the stress laid by Petitioner on the question of fraud, it is peculiar that Petitioner does not fully inform the Court of the facts. Petitioner gives the impression that the question of fraud first arose in the trial of this suit before the District Court. This is not so.

Petitioner first made his charges of fraud to the Patent Office, starting in June 22, 1943, four months before the present suit was filed, and the Patent Office investigation of fraud did not end until May 30, 1944, when the Commis-

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[3] An example of the procedure prior to the 1927 amendment is the *Armstrong-DeForest* litigation, see Radio Corp. v. Radio Engineering Lab, 293 U. S. 1.

[4] If the District Court had followed the suggestion of this Court in *Addison v. Holly Hill Co.*, 322 U. S. 607, 619-623 and had referred the case back to the Commissioner of Patents to see how far the Commissioner of Patents felt himself bound by the decision of the Court of Customs and Patent Appeals, 142 F2d 680, as was done in the Court of Appeals of the District of Columbia, *International Standard Electric Corp. v. Ooms*, 157 F2d 73, the danger of adjudicating under Section 4915 R. S. a question previously adjudicated under Section 4911 R. S. could have been avoided.

sioner of Patents handed down his final decision that there was no fraud. The Patent Office proceedings on the question of fraud occupy over 100 printed pages in Appellants' Appendix No. 10013, pp. 260 a-366 a and the balance of this Appendix with the exception of pp. 409 a-412 a and the upper half of p. 468 a, is taken up with pertinent excerpts from the evidence considered by the Commissioner in this extensive investigation.

The Commissioner of Patents in no way restricted Etten as to matter he chose to present and even held an oral hearing on March 17, 1944, at which Etten could completely state his views. Prior to the March 17, 1944 hearing Etten had taken pre-trial depositions in this case of Walter L. Kauffman, II and the officers of the Lovell Manufacturing Company (Pl. Ex. 134). H. C. Lord as attorney for respondent Lovell attended these depositions but was not called as a witness. The Commissioner of Patents received these pre-trial depositions in evidence and considered them in his final Fact Finding Report of May 23, 1944 (Appellants' Appendix, No. 10013, pp. 316 a-364 a). After losing before the Commissioner Etten did take other pre-trial depositions but there is no showing that these other depositions could not have been taken in time to present to the Commissioner.

The Commissioner in his investigation of fraud was not bound by the Rules of Evidence but could and did notice other facts not specifically offered to him.[5] The Commissioner found as a fact that there was no fraud, reaching a decision diametrically opposite to the District Court. The decisions of the Commissioner of Patents on fraud stand

[5] In this respect the Commissioner of Patent occupies essentially the same position as the Secretary of Interior in connection with patents for public lands. See *Knight v. United Land Association*, 142 U. S. 161 and *West v. Standard Oil Co.*, 278 U. S. 200.

unreversed and unmodified. Etten did not avail himself of the procedure for reviewing the Commissioner's decision. See *Steinmetz v. Allen*, 192 U. S. 543 and *Ex parte Herman Frasch*, 192 U. S. 566.

The District Court did not give to the decisions of the Commissioner of Patents on fraud the presumption of validity which attaches to all regular administrative acts. In fact, the District Court neither noticed nor mentioned the Commissioner's Decisions.

(3) Errors in the Judgment of the District Court Challenged by Respondents.

Petitioner has not fully informed this Court of the issues raised by Respondents in their appeal from the Judgment of the District Court. Petitioner gives the impression that Respondents concede the judgment of the District Court to be correct in every respect and that there remains in this case only what Petitioners terms the "irrelevant, technical questions of title" (Petition, page 13, *et al)*. This impression is not correct. There are substantial errors which Respondents challenge and which the Court of Appeals did not reach upon the merits for fear of rendering an advisory opinion.

(a) *Errors of Law.*

1. The District Court authorized the issuance of a patent on Etten application S. N. 38932, filed September 3, 1935 even though the Jantz Wringer was commercially available to the public generally on June, 1933 more than two years before Etten filed his application. See Appellants' Appendix No. 10013, pp. 399 a-400 a, Jantz Exhibit "P" and Section 4886 R. S. (35 USC 31).

2. The District Court authorized the issuance of a patent on application S. N. 38932 for a claim which had as a specific limitation "an extension forming a handle" despite the square holding of the Patent Office, that Etten proved reduction to practice of no such limitation. See Appellants' Appendix No. 10013, p. 81 a, p. 84 a and p. 92 a. No additional evidence on this point was introduced before the District Court.

3. The District Court did not give to the unreversed and unquestioned decision of the Court of Customs and Patent Appeals, 142 F. 2d 680 the effect of *res judicata.*

4. The District Court misinterpreted and misapplied the holding of this Court in *Morgan v. Daniels,* 153 U. S. 120.

5. The District Court ignored the thorough and painstaking investigation of fraud by the Commissioner of Patents.

6. The District Court authorized the issuance of a patent on reissue application S. N. 167775 containing a claim (Count 3, Interference 76987) INVALID over the prior art. See Foot Note 1 page 4 *supra,* for the tabulation of the claims in the Jantz patent, which shows that Jantz did not receive a patent for this INVALID claim.

7. The District Court did not hold patent 2,054,970 void because Jantz was the prior inventor and further because there was no disclaimer of claim 13 after the Court of Customs and Patent Appeals by its unquestioned judgment, 142 F. 2d 680, held that Etten was not entitled to this claim.

8. The District Court exceeded its authority by declaring the entire Jantz patent void on the ground of fraud, thereby assuming the jurisdiction of a direct cancellation suit.

(b) *Errors of Fact.*

1. By Finding of Fact 13 the District Court found that

> "The counts or claims of Interference Nos. 75433 and 76987 involved in this suit under Section 4915 R. S. are directed to different inventions than the counts or claims of the two companion interference, Nos. 77671 and 77672 * * *"

No evidence supports this finding. Petitioner's admission to the Patent Office quoted above at page 3 is that the inventions of all four interferences were the same. The sameness of the contests in all four interferences is born out by the Patent Office decisions (Appellants' Appendix No. 10013, pp. 77 a-81 a, 85 a-92 a, 98 a-102 a, 106 a-114 a).

2. By Finding of Fact 14 the District Court held

> "* * * each of the aforesaid Etten applications were owned by the plaintiff herein".

This is the ultimate fact which the Court of Appeals found too obscure to determine and therefore remanded the case to the District Court.

3. By Finding of Fact 15 the District Court found

> "H. C. Lord, of Counsel for defendant, * * * negotiated with the aged Jantz * * * to acquire the Jantz application, and purchased the application on March 16, 1938, for defendant Lovell on an installment plan, wherein the final payment of $1500.00 to Jantz was contingent upon either Jantz or Kauffman, being finally adjudged to be the first inventor of the toggle release wringer".

The record does not sustain that H. C. Lord conducted the negotiation. Pl. Exs. 1, 2, 3, 6, 7, 10, 11, 12 and 19. (Appellants' Appendix No. 10013, pp. 374 a-385 a, 387 a) conclusively show that the negotiations were conducted by Lovell and that H. C. Lord, as attorney for Lovell, came into the picture only after Lovell had made an acceptable offer. The false impression that the additional consideration of $1500.00 was to be contingent upon Jantz' winning

the interferences involved in this proceding is particularly erroneous. The plain words of the written purchase agreement (Appellants' Appendix No. 10013, p. 396 a) show that the additional $1500.00 consideration was contingent entirely upon interferences 75431 and 75432, interferences of which the District Court knew nothing, since these latter interferences were never before the District Court.

4. Finding of Fact 16 contains two errors (a) that the Lovell interest in the Jantz application was concealed and (b) that A. F. Herbsleb, attorney for Jantz, was retained by H. C. Lord.

(a) Prior to the taking of the Jantz testimony on October 28, 1940 Etten testified that Lovell was "owner or assignee of the Jantz application in this interference" (Appellants' Appendix No. 10013, p. 431 a, lines 4, 5).

(b) The uncontroverted testimony of Kauffman, A. M. Doll, Herbsleb and Jantz was that Herbsleb was acting as Jantz' attorney throughout (Appellants' Appendix No. 10013, pp. 465 a-468 a). Although of course, Lovell by its purchase agreement with Jantz was obligated to pay such litigation expenses as Jantz incurred (Appellants' Appendix No. 10013, p. 396 a).

5. Finding of Fact 18 states

> "The original preliminary statement (Plaintiff's Exhibit No. 166) executed by Jantz on March 16, 1938, setting forth a date of invention of March 1, 1933, were concealed in the files of H. C. Lord, Attorney for defendants, because the dates alleged therein were subsequent to Etten's filing date of December 23, 1932, and at no time were produced during the Patent Office Interferences."

These preliminary statements were never released by Jantz with intention that they be relied upon. Jantz' contemporaneous April 16, 1938 letter, uncontroverted in the rec-

ord, is that the statements were changed and others substituted "to make them more correct" (Appellants' Appendix No. 10013, p. 401 a). There is no evidence in the record supporting the balance of the Finding.

6. The record does not support Finding of Fact 19, to the extent that this Finding states that the original statements were concealed or suppressed or that they were produced under compulsion in an effort to avoid having Mr. Lord appear in person, in response to the subpoena. The Finding also erroneously refers to "the records of defendants and their counsel" when these so called "records" were pre-trial memoranda and correspondence for the most part dealing with interviews with prospective witnesses.

7. Finding of Fact 20 is not supported by the record, see Pl. Ex.'s 13 and 14 (Appellants' Appendix No. 10013, pp. 401 a-408 a). Also see Appellants' Appendix No. 10013, pp. 118 a, 119 a particularly the colloquy between MR. MERONI and THE WITNESS following XQ. 7.

8. The Finding 21 is in error in stating that the affidavits positively represented "that all of the records of the Corcoran Manufacturing Company had been destroyed." The affidavits (Appellants' Appendix No. 10013, pp. 446 a-462 a, see also pp. 434 a-446 a) merely state that the Corcoran records had been destroyed or *dispersed.* As part of the Jantz case *Corcoran records,* Jantz' Exhibits K and P, were introduced in evidence and Jantz testified as follows:

> "Q75. Have you got anything to indicate an order you got on that trip?
>
> A. May I say that when the business was sold out at auction there were really no records reserved or kept, *—they were all destroyed, except there were some papers which I happened to have on my desk and a bunch I picked up out there and took away, and among them I found a couple of orders for that Model T wringer."* (Emphasis added) (Pl. Ex. 156, p. 18)

9. As to the Findings of Fact 22 and 24, the Jantz testimony as a whole, pertinent excerpts of which are printed at Appellants' Appendix No. 10013, pp. 128 a-259 a supports a 1932 date.

10. In Finding of Fact 23, the date "Fall of 1932" does not appear in the record.

11. Finding of Fact 27 is not supported by the record. There is no evidence that defendants knowingly and deliberately submitted and caused to be submitted to the Patent Office false and untrue evidence and affidavits, while concealing and suppressing other pertinent evidence in the files of their attorneys, H. C. Lord and A. F. Herbsleb.

(4) Respondents' Infringement Counterclaim.

Beyond noting that there is such a counterclaim, Petitioner does not inform the Court of what is involved.

On October 21, 1947 (Petition, p. 6) when the motion to amend under Section 4918 R. S. was granted, the Order (Pleadings No. 10013, p. 87 a) protected Respondents as to Compulsory Counterclaims by allowing 30 days in which to assert counterclaims. This was done on November 20, 1947 when Respondents counterclaimed for infringement of Jantz Patent 2,406,951 and Kauffman Patents 2,201,541, 2,202,778 and 2,233,385, all four patents bearing the same title "Wringer" (Pleadings No. 10013, p. 89 a).

Instead of answering the Counterclaim, Petitioner on December 8, 1947 filed a Motion to Dismiss under Rule 12(b), (Pleadings No. 10013, pp. 90 a-92 a) thereby staying the time for Answer until disposition of the motion. THIS MOTION IS STILL UNDISPOSED OF. No Answer has been filed. No trial has been had. The District Court has never had the Kauffman patents before it and knows nothing of the issues involved.

The infringement counterclaim is certainly compulsory insofar as it involves inventions of the Jantz patent alleged to interfere under Section 4918 R. S. and is probably compulsory as to the Kauffman inventions incorporated in the same commercial structure alleged to infringe the Jantz patent.

5. How the Question of Mootness Came into the Case.

Petitioner does not give the whole story as to how the question of mootness came into the case. This question did not, as Petitioner tries to imply, first arise before the Court of Appeals.

The question of mootness had its inception on December 19, 1947 when Petitioner filed his Supplemental Affidavit in support of his Motion to Dismiss the Infringement Counterclaim. This Supplemental Affidavit, printed at Pleadings No. 10013, pp. 97 a-99 a, was interpreted by Respondents as going so far as to disclaim any interest of petitioner in his patent and applications. Accordingly, on December 30, 1947 Respondents, by Notice, Affidavit, Motion (entitled Request), Memorandum and Interrogatories, brought to the attention of the District Court the apparent lack of a justiciable interest in Petitioner which deprived the District Court of jurisdiction to proceed further with the case (Pleadings No. 10013, pp. 100 a-126 a). Petitioner countered January 9, 1948 (Pleadings No. 10013, pp. 126 a-136 a) with a Motion to Strike and the matter there rested until the Opinion of the District Court filed March 2, 1949, over a year later, which for the first time dealt with the question of title as follows:

> "* * * The proceedings continued over a long period of time and finally reached the point where all parties agreed that the 4915 and 4918 suits were finished business and an order was entered on December 9, 1947,

> confirming this understanding. In the light of this agreement and confirming order, defendant cannot now by dilatory motion be permitted to raise a question of which he was fully cognizant prior to the agreement and order, and which is not predicated on any newly discovered evidence." (Appellants' Appendix No. 10013, p. 55 a).

This was confirmed by paragraph 6 of the Judgment entered April 26, 1949 (Appellants' Appendix No. 10013, p. 57 a). There is nothing in the record to characterize Respondents as dilatory for raising the question December 30, 1947, less than two weeks after Etten by his affidavit of December 19, 1947 disclaimed any interest. There is nothing in (or out of) the record to show that Respondents were even remotely cognizant of Etten's lack of interest until his December 19, 1947 Affidavit.

The District Court accordingly was squarely confronted with the question of mootness over a year before it handed down its initial Opinion.

The Judgment of the District Court of April 26, 1949, (Appellants' Appendix No. 10013, pp. 56 a-57 a) was not final when entered. Defendants submitted an order to the District Court which would take care of some of the loose ends and directed attention to Rule 54(b) FRCP, as amended. When the District Court refused to enter any further order and indicated that it would do nothing further "until the matter has been passed upon by the appellate courts", defendants appealed (Appellants' Appendix No. 10013, pp. 58 a-64 a). This appeal was dismissed because of the absence of a certificate under Rule 54(b), FRCP, as amended (R. 169-171).

Following the Opinion of the Court of Appeals filed January 10, 1950 (R. 169, 170), the question of a justiciable interest in Petitioner was again brought to the attention

of the District Court. Respondents supplied the District Court with certified copies of the Assignment records from the United States Patent Office which show Chamberlain's interest in the suit (Appellants' Appendix No. 10186, pp. 11 a-18 a, Appellees' Appendix No. 10013, pp. 13 a-16 a). Respondents also brought this matter to the attention of the District Court by a motion for an Order (Appellants' Appendix No. 10186, p. 21 a) that both Chamberlain Corporation and Nicholas L. Etten separately answer the interrogatories and go on record as to their respective positions in this suit.

The District Court did not look into petitioner's title nor did the District Court require the answering of the Interrogatories so the facts might be of record. The District Court on March 8, 1950 reentered its previous judgment with the certificate under Rule 54(b) required to make this judgment final and included in that certificate the following gratuitous statements on which Petitioner places great reliance:

> "It is my opinion that grave injustice would be done by requiring the determination of the issues raised in the complaint to await the outcome of any further and undisposed of matters in this cause. Furthermore, all parties specifically agreed to close the proceedings as to the issues raised in the complaint as is set forth in the Order of this Court dated December 9, 1947 and filed December 16, 1947." (Appellants' Appendix No. 10186, pp. 5 a-6 a)

Upon appeal from the March 8, 1950 Judgment, the Court of Appeals found the case in the same posture as on December 30, 1947 when the question of mootness was first raised. Terming the record as "chaotic" and the printed appendices as "grossly inadequate", the Court had recourse to the "original record" (R. 216) and was still unable to determine the question of title. The Court, however, did

decide that there was danger of mootness and did not reach the merits "lest we render an advisory opinion" (R. 220).

Contrary to the statement repeated at pages 10, 11, 13 of the Petition and at pages 7, 11, 17 of Petitioner's Brief, the Court of Appeals did not decide or admit or concede that it or the Court below had jurisdiction of Petitioner's claim.

Argument.

The desirability of having the owner of property in litigation before the court so he cannot later complain that he has not had his day in court, should not be seriously questioned. Nor should it be doubted that a plaintiff who has no interest has no standing to sue. No court should be asked for advice as to what its decision would be if an interested plaintiff sued.

These fundamental propositions demonstrate the correctness of the Judgment of the Court of Appeals in this case and are sufficient to deny the petition. The Court of Appeals seriously doubted that petitioner had a justiciable interest[6]. Accordingly, it refused to reach the merits and to consider the errors of fact and law before it on appeal. The Interlocutory Judgment (R. 222) vacating the Judgment of the District Court was the proper procedure, *United States v. Munsingwear,* 340 U. S. 36.

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[6] While the Court of Appeals, even after examining the original papers (R. 216) felt it had not "wound out fully the labyrinth of assignments, titles and interests" (R. 219) the Patent Office in the papers declaring these interferences unquestionably designated Chamberlain Corporation the assignee of petitioner (Appellants' Appendix No. 10013, pp. 73a, 95a). See also Appellants' Appendix No. 10013, pp. 527a, 528a, 475a and Appellants' Appendix No. 10186, pp. 11a-14a for further Patent Office records of Chamberlain's interest.

However, petitioner says there are important points which warrant overlooking the absence of judicial authority to proceed and which require examination of the merits by this Court. These are:

(1) Under Section 4915 and 4918 R. S., the inventor who has sold his invention still remains the applicant or interested party.

(2) The public interest in fraud warrants review even though petitioner has no interest.

(3) Rules 25(c) and 54(b).

THE INVENTOR WHO SELLS HIS INVENTION IS NO LONGER THE APPLICANT UNDER SECTION 4915 R. S. NOR THE INTERESTED PARTY UNDER SECTION 4918 R. S.

(1) The weight of authority is that the assignee of the inventor becomes the "applicant" under Section 4915 R. S. The reason for this was first pointed out by Mr. Justice Nelson (sitting on the Circuit Court) in *Gay v. Cornell,* 1 Blatch 506 Fed. Case No. 5280 CCNY (1849) and has been followed in *Becker v. General Chain,* 273 Fed. 419 CA 1 (1921) and *Garfield v. Western Electric,* 298 Fed. 659 S. D. N. Y. (1924). The case from which petitioner quotes so extensively, *Colman v. American Warp Drawing Machine Co.,* 235 Fed. 531 D. Mass. (1915) was dictum and in any event must be deemed overruled or deprived of its force by the Court of Appeals in *Becker v. General Chain, supra.*

The reason the inventor's assignee becomes the "applicant" under Section 4915 R. S. is not hard to see. Patents are entirely statutory and the obligations and privileges must be found in the Patent Statutes. The purchaser of an invention is entitled to make application for patent provided the application is executed by the inventor, Section

4895 R. S. The purchaser then assumes the status of an applicant to whom a patent may be granted. This status is derived from the Patent Statutes and not from the law of contracts. That the purchaser could apply for a patent on the invention he purchased has been part of the Patent Statutes since 1837. See Appendix p. 23.

It appears from *Becker v. General Chain,* 273 Fed. 419 CA1 (1921) and *Garfield v. Western Electric,* 298 Fed. 659 S. D. N. Y. (1924) that any supposed conflict with the earlier dictum of the District Court in *Colman v. American Warp Drawing Machine,* 235 Fed. 531, D. Mass. (1915) has already been resolved and needs no reexamination by this Court. The successive amendments to Section 4915 R. S. while preserving the right to sue in the "applicant", must be deemed to have adopted the prior judicial construction. See Appendix pp. 24-26.

Of course, the inventor who has sold his invention no longer is interested in the patent which may be obtained on the invention as specified in Section 4918 R. S. See Appendix, p. 27.

Fraud.

(2) Respondents are not trying to avoid appellate consideration of fraud. Respondents wish to upset the decision of the District Court which they believe erroneous.

Respondents do wish to point out that the public interest in fraud has been protected, in the first instance, by the Commissioner of Patents (Appellants' Appendix No. 10013, pp. 260 a-366 a) and that petitioner has not availed himself of the remedies for questioning the Commissioner's decision, *Steinmetz v. Allen,* 192 U. S. 543. See *ex parte* Frasch 192 U. S. 566 holding that mandamus and not appeal is the correct remedy.

However, petitioner's interest in the claim for damages for fraud is certainly no greater than his interest in the patent and applications. None of the assignments between Etten and Chamberlain mentions any claim for past damages. The right of action for such damages is personal to the owner and does not pass with the patent or application, *Crown Die & Tool v. Nye Tool and Machine Works*, 261 U. S. 24, 44. See also *Mendez v. Bowie*, 118 F. 2d 435, 439.

In other words, the claim for damages for fraud can only be asserted by the owner of the patent or applications at the time the alleged fraud was committed. This involves scrutiny of precisely the same documents of title involved in the claims under Sections 4915 and 4918. The Court of Appeals accordingly did not err in treating the petitioner's claim for damages on the same basis as the claims under Sections 4915 and 4918.

Rules 25(c) and 54(b).

(3) Rule 25(c) has no application to a case where it is doubted that the Court had jurisdiction when the suit was filed. Petitioner apparently realizes the weakness of this point and repeatedly misstates that the Court of Appeals *conceded* jurisdiction when the suit was filed. This is not so.

Rule 54(b) certainly goes no further than making a partial judgment appealable. While possibly Rule 54(b) forecloses appellate scrutiny of a certificate by the District Court that a partial judgment be final, even a partial judgment such as the present case which does not dispose of a compulsory counterclaim, there is certainly nothing in Rule 54(b), or any other Rule, which forecloses scrutiny of gratuitous statements explaining why the certificate is

made. Rule 54(b) does not foreclose appellate scrutiny of facts. In this case, the facts appearing in the record do not support any "grave injustice" or irreparable injury to petitioner[1] which would warrant consideration of this case before the question of mootness has been cleared up.

Conclusion.

If the procedure suggested by the Court of Appeals is followed it may be unnecessary to reach any of the questions raised by a decision on the merits. There is no exceptional reason for reviewing the Interlocutory Judgment of the Court of Appeals. It is respectfully submitted that the petition for a writ of certiorari should be denied.

RALPH HAMMAR,
FRANK ZUGELTER,
Attorneys for Respondents.

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[1] Petitioner begs the question on page 28 of his Supporting Brief by asserting irreparable injury because "petitioner's patent" (2,054,970) will expire in 1953 and his "reissue application" has been held up pending the outcome of this litigation. The Court of Appeals felt that petitioner's title, if any, was too obscure for decision on the present record.

APPENDIX.

Sec. 4895 R. S. (U. S. C., title 35, sec. 44.) Patents may be granted and issued or reissued to the assignee of the inventor or discoverer; but the assignment must first be entered of record in the Patent Office. And in all cases of an application by an assignee for the issue of a patent, the application shall be made and the specification sworn to by the inventor or discoverer; and in all cases of an application for a reissue of any patent, the application must be made and the corrected specification signed by the inventor or discoverer, if he is living, unless the patent was issued and the assignment made before the eighth day of July, eighteen hundred and seventy.

Section 6, Patent Act of 1837; 5 Stat. 191 And be it further enacted, That any patent hereafter to be issued may be made and issued to the assignee or assignees of the inventor or discoverer, the assignment thereof being first entered of record, and the application therefor being duly made, and the specification duly sworn to by the inventor. And in all cases hereafter, the applicant for a patent shall be held to furnish duplicate drawings, whenever the case admits of drawings, one of which to be deposited in the office, and the other to be annexed to the patent, and considered a part of the specification.

Section 33, Consolidated Patent Act of 1870; 16 Stat. 198 And be it further enacted, That patents may be granted and issued or re-issued to the assignee of the inventor or discoverer, the assignment thereof being first entered of record in the Patent Office; but in such case the application for the patent shall be made and the specifications sworn to by the inventor or discoverer; and also, if he be living, in case of an application for re-issue.

Section 4915 R. S. as amended by Section 9, Act of Feb. 9, 1893, 27 Stat. 436; Section 11, Act of March 2, 1927, 44 Stat. 1336; Section 2 (b), Act of March 2, 1929, 45 Stat. 1476 (USC, title 35 sec. 63). Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals[1] to the United States Court of Customs and Patent Appeals[2], and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. (balance omitted.)

Section 4915 R. S. as approved June 22, 1874. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court

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[1] Sec. 6 of Act of March 2, 1927 repealed Section 4910 R. S. which provided for appeals from the Examiners-in-Chief (now Board of Appeals) to the Commissioner in person.

[2] Sec. 9 of Act of Feb. 9, 1893 transferred the jurisdiction of the Supreme Court of the District of Columbia to the Court of Appeals of the District of Columbia. Sec. 2(b) of Act of March 2, 1929 transferred the jurisdiction of the Court of Appeals of the District of Columbia to the United States Court of Customs and Patent Appeals.

having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. (balance omitted)

Section 52 of Consolidated Patent Act of 1870, 16 Stat. 198. And be it further enacted, That whenever a patent on application is refused for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. (balance omitted)

Section 10 of Patent Act of 1839, 5 Stat. 353. And be it further enacted, That the provisions of the sixteenth section of the before-recited act (Patent Act of 1836)* shall extend to all cases where patents are refused for any reason what-ever, either by the Commissioner of Patents or by the

* Matter in parentheses inserted.

Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by applicant, whether the final decision shall be in his favor or otherwise.

Section 16 of Patent Act of 1836, 5 Stat. 117. And be it further enacted, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided*

however, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

Section 4918 R. S., as Amended by Section 12, Act of March 2, 1927, 44 Stat. 1337. (U. S. C., title 35, sec. 66) Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either *or both* the patents void in whole or in part *upon any ground,* or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment. *(Amendments in Italics.)*